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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

Application No. : 09/638,032
Confirmation No. : 5400
Applicant : T. Kanemitsu
Filed : Aug. 15, 2000
Title : Method of producing a rotary member made
of a metallic plate
TC/A.U. : 3725
Examiner : L. A. Larson
Docket No. : KANE3012/FJD
Customer No. : 23364

REPLY BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22202-3514

Sir:

INTRODUCTORY COMMENTS

Receipt of the Examiner's Answer dated January 25, 2007 is gratefully acknowledged.

The following Reply is being submitted pursuant to the provisions of 37 CFR 41.41(a).

REPLY

The noted Examiner's Answer raises several points which require commentary.

(1)

In the Board's Decision dated June 15, 2000, the Board stated at page 7:

We find no express teaching in the original disclosure, including the original claims, that at the end of appellant's process the boss 6 and the annular flat portion 5 or the boss 6, the annular flat portion 5 and the peripheral wall 7 have substantially the same thickness.

The Board is correct in that there is no "express" disclosure of the "same thickness" distinction. This distinction is, however, inherent when one considers the totality of the disclosure.

The Board recognized the inherency position and stated, also on page 7:

In order for a disclosure to be inherent, however, the missing descriptive matter must necessarily be present in the original disclosure of the application such that one skilled in the art would recognize such a disclosure.

Appellant agrees. What Appellant does not agree with is the conclusion that the Board reached. The Board stated, again on page 7:

There is nothing in the original disclosure suggesting, much less necessarily requiring, that the boss 6 and the annular flat portion 5 or the boss 6, the annular flat portion 5 and the peripheral wall 7 have substantially the same thickness at the end of the appellants' process.

But there is. Some of the quoted portions of the specification will be repeated for completeness here. First, note page 3, lines 14-22 of the specification, which states:

. . . the present invention is proposed with the object of providing a method of producing a rotary member made of a metallic plate, capable of forming, with high precision, only a boss or both a boss and a peripheral wall each having a predetermined diameter, **a predetermined thickness** and a predetermined height, with the use of a small press machine without **the thickness of the initial** material reduced so much in the source of production steps. (emphasis added).

Note the reference to "thickness" not thicknesses. There is only one thickness, and that is quite clear.

Again on page 4, lines 20-22, and page 6, lines 17 - 19, it is stated:

This restrains the blank from being ***reduced in thickness*** due to a plastic flow of the blank material (emphasis added).

Also, on page 18, lines 1 - 4, it is stated:

A desired thickness and a desired projecting height, such formation being made by combining kinds of bending operations so that ***the original thickness of the blank*** is not decreased so much in the course of production steps. (emphasis added).

The blank starts with a given thickness, that is clearly seen in Fig. 1A. If the thickness one starts with is uniform (given thickness) and its thickness is not reduced (there is no disclosure that it is), then its thickness is the same in all its parts. Even assuming that the thickness is greater or less than the thickness of the original blank, the point is that it is the same in its various parts when the process is complete. This conclusion is not beyond the level of understanding of the person of ordinary skill in the art.

(2)

In his Examiner's Answer, the examiner states at the bottom of page 3 and top of page 4 that at four places in the specification "the 'curving' steps as claimed are described in the specification as drawing steps." On pages 10, lines 21 and 22; page 13, line 13, and page 14, lines 21 and 22, the specification states "curving (drawing) step." This does not mean that curving does not occur but that the curving is achieved by drawing. There is still curving, and that is what is important along with bending. Refer again to page 4, lines 6 - 14 of the specification. The point is that there is curving and bending using different molds. Why is this disclosure not enabling? The Board in

their decision of June 15, 2000 does not tell us, nor has the examiner in this continuation application. The Board does states on page 5 that:

It is clear from the original disclosure that some
flow occurs as a result of the various deforming
steps depicted in the appellants' Figures 1A to 7B.

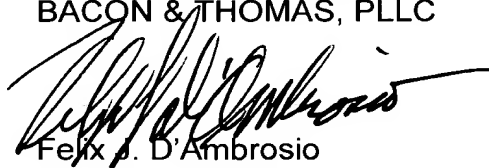
Apparently, this "flow" leads the Board to conclude that the thickness cannot be maintained. But that does not necessarily follow because the boss 6 is simply increased in height. That would have to be the case if the free end of the curved plate is restrained as mentioned in the specification. As discussed above in (1) the thickness of the finished product, the rotary member can have the same thickness throughout.

(3)

Appellant is not asking that the drawings alone should be considered as support for the same thickness distinction, but that the drawings together with the disclosure, in particular that noted above, be considered together.

Date: March 26, 2007

Respectfully submitted
BACON & THOMAS, PLLC


Felix J. D'Ambrosio
Reg. No. 25,721

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, VA 22314
Tel: (703) 683-0500
Fax: (703) 683-1080

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